



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,241	04/23/2001	Robert Krause	08049.0765	4011

22852 7590 12/02/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,241	KRAUSE ET AL.	
	Examiner	Art Unit	
	Daniel L. Greene	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/29/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-20,55-80,115-122,126-142 and 177-184 is/are pending in the application.
- 4a) Of the above claim(s) 1-3,21-54,81-114,123-125 and 143-176 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-20, 55-80, 115-122, 126-142 and 177-184 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/29/2005 have been fully considered but they are not persuasive. The Applicant argues that neither Goodman nor Lockhart et al. teaches or suggests electronically processing the change of address information. Goodman discloses as per the Abstract, " A service computer receives the change of address information from all the terminals, and in response thereto, the postal service and others desiring the change of address information are notified, ...". The Examiner submits that the notification is done and the changes made electronically.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and incorporate procedures for validating the identity of the person submitting the address change request. Lockhart et al provide motivation by indicating that the conventional means by which a user would notify the postal service of an address change is both insecure and time-consuming (0090). Thus, the method of validating the identity of the requester disclosed by Lockhart et al would provide

Art Unit: 3621

additional measures of security and greater assurances to prevent an unauthorized person to enter an address change.

In response to applicant's argument that Tsuei is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tsuei is about mail delivery the same as Goodman and Lockhart et al. The Applicant argues that an e-mail address differs from a physical address and therefore is not relevant. The Examiner disagrees in that whether it is an e-mail address or a physical address they both serve the same purpose and as shown, managed in the same way.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 8-13, 55-56, 58, 60-66, 68-73, 115-116, 118, 120-122, 126, 128, 130-135, 177, 180 and 182-184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman, U.S. Patent No. 5,146,403 in view of Lockhart et al, U.S. Patent Application Publication No. US 2002/0103697 A1.

As per **Claims 4, 6, 8-9, 13, 63-64, 66, 68-69, 73, 126, 128, 130-131 and 135,**

Goodman discloses a method for providing an electronic change of address service including a plurality of sub-services from an old address of a customer to a new address of the customer, comprising:

- providing a user interface at a change of address server for the customer to enter change of address information (Figure 1; 2C; Col. 2, lines 35-48; Col. 6, lines 30-42; Col. 7, lines 35-43; Col. 10, lines 14-21; Col. 10, lines 40-45; Col. 11, lines 30-37);
- receiving the change of address information at the change of address server via a network (Col. 2, lines 40-48; Col. 3, lines 35-45; Col. 4 line 65-Col. 5 line 5; Col. 6, lines 45-65; Col. 9, lines 57-66; Col. 10, lines 5-10);
- electronically transferring the change of address information to a service center (Col. 2, lines 40-48; Col. 3, lines 35-45; Col. 4, lines 30-35; Col. 4 line 65-Col. 5, line 5; Col. 6, lines 45-65);
- forwarding the change of address information electronically from the service center to at least one of the sub-services within the change of address service (Col. 2, lines 40-48; Col. 3, lines 35-45; Col. 4, lines 1-14; Col. 4, lines 30-35; Col. 4 line 65-Col. 5 line 5; Col. 6, lines 45-65; Col. 10, lines 14-21); and
- processing the change of address information received from the service center electronically to enable the customer to receive mail addressed to the old address of the customer at the new address of the customer (Col. 2, lines 40-48; Col. 3, lines 40-45; Col. 6, lines 45-65; Col. 10, lines 14-21).

Goodman, however, fails to explicitly disclose validating an identity of the customer at the change of address server. Lockhart et al disclose a method for generating and distributing mail items and further teach a secure address change feature wherein an address change form is supplied to the user online, the user fills out the form and a validation procedure is conducted to verify the customer as well as the address information based on a series of information previously provided by the user such as credit card information and address data (0090-0091). Lockhart et al further disclose a login/signup procedure followed by the user in order to authenticate the user when entering the mail service computer (0082-0084). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and incorporate procedures for validating the identity of the person submitting the address change request. Lockhart et al provide motivation by indicating that the conventional means by which a user would notify the postal service of an address change is both insecure and time-consuming (0090). Thus, the method of validating the identity of the requester disclosed by Lockhart et al would provide additional measures of security and greater assurances to prevent an unauthorized person to enter an address change.

As per **Claims 5 and 127**, Goodman further discloses wherein forwarding the change of address information includes:

- formatting the change of address information to be uploaded to a forwarding service unit (Col. 14, lines 20-26; Col. 20 line 67-Col. 21 line 10; Col. 21, lines 50-60);

- uploading the change of address information to the forwarding service unit (Col. 2, lines 40-48; Col. 3, lines 35-45; Col. 4, lines 30-35; Col. 4 line 65-Col. 5, line 5; Col. 6, lines 45-65).

As per **Claims 10-12, 70-72 and 132-134**, Goodman and Lockhart et al fail to disclose wherein the verification information is a digital certificate, government ID or a university ID. Examiner takes Official Notice, however, that these are well known and established means for identifying an individual and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use any one of these methods as well as others for verifying the identity of the user for well known reasons.

As per **Claims 55, 115 and 177**, Goodman discloses a method for providing an electronic change of address service from an old address of a customer to a new address of the customer, comprising:

- providing a user interface at a change of address server for the customer to enter change of address information (Figure 1; 2C; Col. 2, lines 35-48; Col. 6, lines 30-42; Col. 7, lines 35-43; Col. 10, lines 14-21; Col. 10, lines 40-45; Col. 11, lines 30-37);
- processing the change of address information received from the service center electronically to enable the customer to receive mail addressed to the old address of the customer at the new address of the customer (Col. 2, lines 40-48; Col. 3, lines 40-45; Col. 6, lines 45-65; Col. 10, lines 14-21);

- providing an additional service to the customer to assist the customer in changing from the old address to the new address (Col. 2, lines 40-50; Col. 3, lines 5-16; Col. 4 line 65-Col. 5 line 5; Col. 9, lines 30-38; Col. 9 line 65-Col. 10 line 20; Col. 24, lines 14-20).

Goodman, however, fails to explicitly disclose validating an identity of the customer at the change of address server. Lockhart et al disclose a method for generating and distributing mail items and further teach a secure address change feature wherein an address change form is supplied to the user online, the user fills out the form and a validation procedure is conducted to verify the customer as well as the address information based on a series of information previously provided by the user such as credit card information and address data (0090-0091). Lockhart et al further disclose a login/signup procedure followed by the user in order to authenticate the user when entering the mail service computer (0082-0084). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and incorporate procedures for validating the identity of the person submitting the address change request. Lockhart et al provide motivation by indicating that the conventional means by which a user would notify the postal service of an address change is both insecure and time-consuming (0090). Thus, the method of validating the identity of the requester disclosed by Lockhart et al would provide additional measures of security and greater assurances to prevent an unauthorized person to enter an address change.

As per **Claims 56, 116 and 178**, Goodman further discloses wherein the additional service is a notification service for notifying a company or individual that the customer changed from the old address to the new address comprising:

- providing a list of companies in a user interface (Col. 3, lines 40-64; Col. 4, lines 1-10; Col. 9 line 67-Col. 10 line 5; Col. 10, lines 35-40 and 50-55);
- receiving a customer selection of a company to notify (Col. 3, lines 5-16 and 40-64; Col. 9 line 67-Col. 10 line 5; Col. 10, lines 35-40 and 50-55; Col. 11, lines 30-38; Col. 13, lines 60-67); and
- notifying the selected company of the customer's change of address (Col. 2, lines 40-48; Col. 4, lines 64-68; Col. 6, lines 33-43; Col. 10, lines 10-21).

As per **Claims 58, 118 and 180**, Goodman further discloses wherein the additional service is a notification service to the customer for notifying a company or individual that the customer changed from the old address to the new address comprising:

- receiving a mailing address or downloading a mailing address list from the customer for a designated individual or company (Col. 4, lines 50-55; Col. 4 line 65-Col. 5 line 5; Col. 9 line 65-Col. 10 line 5; Col. 10, lines 35-40 and 50-55; Col. 11, lines 30-38); and
- mailing a mail piece to the designated individual or company describing the customer's change of address (Col. 4, lines 50-55; Col. 4 line 65-Col. 5 line 5; Col. 9 line 65-Col. 10 line 5; Col. 10, lines 35-40 and 50-55; Col. 11, lines 30-38).

As per **Claims 60-61, 120-121 and 182-183**, Goodman fails to disclose, however, Lockhart et al disclose wherein the additional service includes a service for reestablishing contact with a second customer who has changed an address from a second old address to a second new address comprising:

- receiving a request from the customer having the second old address of the second customer to re-establish contact with the second customer (0037);
- determining the second new address for the second customer based on a database storing archived change of address information including the second old address and the second new address (0037); and
- providing the new address of the customer to the second customer at the second new address (0036).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and incorporate the ability to re-establish contact with a second customer using an old address of the customer to determine the new address of the customer as taught by Lockhart et al. Lockhart et al provides motivation by indicating that this is useful for users logging on to the system who need to search for the current address of a party based upon an old address that a user might already know (0037).

As per **Claims 62, 122 and 184**, Goodman fails to disclose, however, Lockhart et al disclose wherein the additional service includes a service for providing electronic

Art Unit: 3621

advertisements from a business to the customer based on the change of address information (0037). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and include a service for providing electronic advertisements from business to the customer based on the change of address information as taught by Lockhart et al. Lockhart et al provides motivation by suggesting that this feature would enable businesses to effectively track the location of their customers for direct marketing purposes (0037).

As per **Claim 65**, Goodman fails to disclose, however, Lockhart et al disclose wherein the old address and new address are electronic addresses (0023; 0033). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and include the ability to change e-mail address information as well as mailing address information as taught by Lockhart et al to enable users to change a plurality of information applicable to their contact information.

4. Claims 7, 14-20, 59, 67, 74-80, 119, 129, 136-142 and 181 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman, U.S. Patent No. 5,146,403 in view of Lockhart et al, U.S. Patent Application Publication No. US 2002/0103697 A1 and Tsuei, U.S. Patent No. 6,654,779 B1.

As per Claims 7, 14, 18-19, 67 and 74, 78-79, 129, 136 and 140-141, Goodman discloses a method for providing an electronic change of address service including a plurality of sub-services from an old address of a customer to a new address of the customer, comprising:

- providing a user interface at a change of address server for the customer to enter change of address information (Figure 1; 2C; Col. 2, lines 35-48; Col. 6, lines 30-42; Col. 7, lines 35-43; Col. 10, lines 14-21; Col. 10, lines 40-45; Col. 11, lines 30-37);
- receiving the change of address information at the change of address server via a network (Col. 2, lines 40-48; Col. 3, lines 35-45; Col. 4 line 65-Col. 5 line 5; Col. 6, lines 45-65; Col. 9, lines 57-66; Col. 10, lines 5-10);
- processing the change of address information received from the service center electronically to enable the customer to receive mail addressed to the old address of the customer at the new address of the customer (Col. 2, lines 40-48; Col. 3, lines 40-45; Col. 6, lines 45-65; Col. 10, lines 14-21).

Goodman, however, fails to explicitly disclose validating an identity of the customer at the change of address server. Lockhart et al disclose a method for generating and distributing mail items and further teach a secure address change

feature wherein an address change form is supplied to the user online, the user fills out the form and a validation procedure is conducted to verify the customer as well as the address information based on a series of information previously provided by the user such as credit card information and address data (0090-0091). Lockhart et al further disclose a login/signup procedure followed by the user in order to authenticate the user when entering the mail service computer (0082-0084). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and incorporate procedures for validating the identity of the person submitting the address change request. Lockhart et al provide motivation by indicating that the conventional means by which a user would notify the postal service of an address change is both insecure and time-consuming (0090). Thus, the method of validating the identity of the requester disclosed by Lockhart et al would provide additional measures of security and greater assurances to prevent an unauthorized person to enter an address change.

Goodman and Lockhart et al also fail to disclose sending the received identification verification information to a third party for validating the identity of the customer. Tsuei disclose a system for changing address information and further teach a security and authentication means for ensuring that address change requests are valid and authentic (Abstract). Tsuei discloses wherein the system receives address change information along with consumer identity information and forwarding the identity information to an authenticating authority for authenticating the identity of the user (Col. 10 line 47-Col. 11 line 33). Accordingly, it would have been obvious to one of ordinary

Art Unit: 3621

skill in the art at the time of applicant's invention to modify the methods of Goodman and Lockhart et al and include using a third party authenticator to authenticate the identity of the user to provide greater assurances of a valid address change request (Col. 11, lines 1-6).

As per **Claims 15-17, 75-77 and 137-139**, Goodman and Lockhart et al fail to disclose wherein the verification information is a digital certificate, social security number, government ID or a university ID. Examiner takes Official Notice, however, that these are well known and established means for identifying an individual and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use any one of these methods as well as others for verifying the identity of the user for well known reasons.

As per **Claims 20, 80 and 142**, Goodman, Lockhart et al and Tsuei fail to explicitly disclose determining whether the credit card information matches fraudulent credit card information stored on a database and validating the identity when there is no match. Examiner takes Official Notice, however, that this was a well known procedure at the time of applicant's invention and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this well known procedure to identify fraudulent credit card transactions.

As per **Claims 59, 119 and 181**, Goodman and Lockhart et al fail to disclose the limitations of this claim. Tsuei discloses a system for electronic mail address management and further teach an e-mail forwarding service comprising:

- creating a deflector record containing an address of an old e-mail service provider, which provides e-mail service to the customer at the old address, and an address at the forwarding service (Figure 3; Col. 6, lines 20-55; Col. 6 line 65-Col. 7 line 17);
- sending the deflector record to the old e-mail service provider for transferring the e-mail from the old e-mail service provider to the forwarding service (Col. 6, lines 45-54);
- receiving the e-mail at the forwarding service from the old service provider (Col. 7, lines 8-17); and
- re-routing the e-mail to the new e-mail address (Col. 7, lines 14-17).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and Lockhart et al by incorporating the e-mail forwarding features as taught by Tsuei. One would have been motivated to incorporate these features to allow for address change and mail forwarding procedures for electronic mail addresses as well as conventional mail addresses providing additional conveniences to the user.

5. Claims 57, 117 and 179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman, U.S. Patent No. 5,146,403 in view of Lockhart et al, U.S. Patent Application Publication No. US 2002/0103697 A1, as applied above, and further in view of Salta, U.S. Patent Application Publication No. US 2001/0037463 A1.

As per **Claims 57, 117 and 179**, Goodman and Lockhart et al fail to disclose a notification service wherein an e-mail address or e-mail address list is received from the customer for a designated individual or company and sending an e-mail message to the designated individual or company describing the customer's change of address. Salta discloses a system and method for notifying parties regarding changes in name, address and/or e-mail information and further discloses receiving an e-mail address from the customer for a designated individual or company and sending an e-mail message to the designated individual or company describing the customer's change of address (0005; 0033-0036). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Goodman and Lockhart et al and include the ability to notify individuals of a persons address change via e-mail rather than regular mail as taught by Salta. Salta provides motivation by indicating that this feature provides a reliable and flexible notification service to deliver to designated persons or businesses via e-mail or regular mail (0005).

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

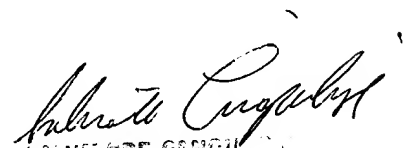
Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

11/22/2005


SALVATORE CARCINELLA
PRIMARY EXAMINER
ART UNIT 222